

REMARKS

This Amendment is prepared in response to the first Office action mailed on 19 September 2006 (Paper No. 20060809). Upon entry of this amendment, claims 1 through 33 will be pending. Applicant has amended claims 2, 20, 21 and 31 by this amendment and has newly added claims 32 and 33 by this amendment.

Claim Objections

On Page 2 of Paper No. 20060809, the Examiner objected to claim 31 because of an informality. Applicant has amended claim 31 by this amendment to state that it depends from claim 21, the same claim from which claim 31 depended from when Applicant's application was originally filed.

Claim Rejections under 35 U.S.C. §112

On Page 2 of Paper No. 20060809, the Examiner rejected claims 7, 9, 14, 15 19-22 and 27 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner stated that the phrases less than a certain number of inches, not more than a certain number of inches, not to exceed a certain number of inches are relative terms which renders a claim indefinite. Applicant disagrees.

Applicant submits that MPEP 2173.05 (b) discusses relative terminology in claim language.

Specifically, MPEP 2173.05 (b) states, “The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” Applicant submits that the MPEP never says that the use of relative terminology is indefinite, instead, relative terminology only in certain circumstances is indefinite. Applicant submits that the MPEP states that relative claim terminology is indefinite only when one having ordinary skill in the art does not understand what is claimed, in light of the specification. In the present patent application, Applicant claims the dimensions of the postcard, the recording unit and the PCB are less than a specific number of inches. Because Applicant uses fixed number of inches in the claims, and because Applicant claims that the dimensions are either less than or less than or equal to some fixed amount of inches, Applicant submits that Applicant’s claim language is precise to one having ordinary skill in the art. In Applicant’s claims, the reference is not a variable but a fixed number of inches. Further, Applicant’s term of degrees are precise. Applicant submits that “less than” and “not to exceed” are precise terms as there is absolutely no doubt as to what Applicant is claiming in claims 7, 9, 14, 15, 19-22 and 27. Therefore, Applicant traverses the 35 U.S.C. 112, second paragraph rejections of Paper No. 20060809.

Prior Art Claim Rejections

In Paper No. 20060809, the Examiner rejected claims 1-31 under 35 U.S.C. §103(a) as being

unpatentable over Ohara *et al.* (US 6356,626) in view of Johnson *et al.* (US 5,063,698). Applicant has the following comments:

Regarding each of Applicant's independent claims 1, 9, 14 and 19, Applicant claims a postcard. On Page 4 of Paper No. 20060809, the Examiner states that Johnson teaches a postcard while citing col 3, lines 52-68 of Johnson. Applicant disagrees. Applicant has reviewed the entire Johnson reference, including col 3, lines 52-68 of Johnson, and can not find any evidence of a postcard. Applicant submits that Johnson, unlike Applicant's invention, teaches a greeting card. Applicant submits that a greeting card is entirely different from a postcard. Unlike a greeting card, a postcard is not folded so it need not be opened up to press the play button. Also, the postcard, unlike a greeting card, does not need an envelope to be mailed through the postal service. Applicant submits that Applicant's invention is unique because, unlike Johnson, Applicant's postcard does not need an envelope and does not need to be opened to press the play button. Because Applicant claims a postcard and the applied prior art does not teach a postcard, Applicant traverses the rejection of independent claims 1, 9, 14 and 19.

Regarding Applicant's claims 4, 17 and 26, Applicant claims an EEPROM. On Page 5 of Paper No. 20060809, the Examiner states, "Regarding claim(s) 4 and 17, Ohara discloses a system, said memory comprising an EEPROM being automatically overwritten by a subsequently recorded message (col 13, lines 17-35)." Applicant disagrees. Applicant has reviewed the entire reference to Ohara, including col 13, lines 17-35 of Ohara, and can find no evidence or mention of an

EEPROM. Therefore, Applicant submits that the rejection of claims 4, 17 and 26 are without merit.

Regarding Applicant's claims 16, 23, 30 and 31, Applicant claims that the postcard is covered with vinyl enabling a user to write thereon. Although the Examiner addressed these claims in Paper No. 20060809, Applicant submits that the Examiner never addressed the vinyl siding limitations of these claims. Applicant has further reviewed each of Ohara and Johnson and can not find any mention of vinyl. Therefore, Applicant submits that the applied prior art can not possibly teach Applicant's claims 16, 23, 30 and 31. Therefore, the rejection of claims 16, 23, 30 and 31 is unwarranted.

Regarding Applicant's claim 29, Applicant claims a pair of 3 volt Lithium Ion batteries. In Paper No. 20060809, although the Examiner refers to claim 29, Applicant submits that the Examiner never addressed this limitation in Paper No. 20060809. Further, Applicant has reviewed Ohara and can not find any evidence of a pair of 3 volt Lithium Ion batteries in Ohara. Therefore, Applicant submits that the rejection of claim 29 is unwarranted.

Regarding Applicant's claim 9, Applicant claims "inserting said postcard ... into a slot of a recording unit ...". Although the Examiner, in Paper No. 20060809, rejected this claim on Pages 3 and 4, this limitation was never addressed. Applicant objects as this is evidence of an incomplete Office action. Applicant further submits that if Ohara were to be modified according to Johnson, Applicant's claim 9 would not result. This is because Johnson does not teach placing a postcard on

a recording device. Instead, Johnson teaches attaching only a memory IC 22 to the recording unit of FIG. 3 for recording and then moving only the memory IC 22 to the greeting card 10 for attachment. Applicant submits that the greeting card 10 nor the rest of the circuit (i.e., the battery, the voice synthesizer) are not attached to the recorder in Johnson. Applicant submits that if Ohara were to be modified according to Johnson, Applicant's claimed invention would not result as there is no teaching in any of the references of inserting a postcard onto a recorder for recording.

Regarding Applicant's claims 1, 6, 14, 24, Applicant claims that the recording unit is powered by the postcard. Applicant submits that if Ohara were to be modified according to Johnson, such a structure would not result. This is because Johnson teaches that the memory IC 22 is detached from the greeting card 10 and is detached from battery 30 when attached to the recorder of FIG. 3 of Johnson for recording. Therefore, Applicant submits that battery 30 of Johnson can not possibly power the recorder of FIG. 3 of Johnson. Applicant submits that if Ohara were to be modified according to Johnson, the battery inside the card would not be used to power the recording unit as claimed by Applicant. Therefore, Applicant traverses the rejection of claims 1, 6, 14 and 24.

Applicant has amended claim 2 by this amendment to correct for an error. Applicant has amended claims 20 and 21 to more definitely define the acronym PCB. Applicant has newly added claims 32 and 33 by this amendment to claim that Applicant's postcard has a foam layer between the vinyl layers as illustrated in FIG. 5. Entry of and favorable examination are respectfully requested.

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In view of the above, it is requested that the election requirement be withdrawn. It is further submitted that the application is in condition for examination on the merits, and early allowance is requested.

No other issues remaining, reconsideration and favorable action upon all of the claims now present in the application is respectfully requested.

A fee of \$50 is incurred by the filing of this amendment for the addition of two more claims in excess of 20 for A SMALL ENTITY.

Respectfully submitted,



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